With regard to argument (1), there is no supporting fact for this discussion, only some conjecture. The essence of the argument is that "furnace or air cooling" equates with "slow cooling" (terms that do not appear in the present claims and were introduced by the Examiner), which equates with the recited claim limitation "a second cooling rate that does not exceed about 15°F per second". Put the other way around, had Applicant started with a claim limitation of "furnace or air cooling" or "slow cooling" and wished to substitute a limitation "a second cooling rate that does not exceed about 15°F per second" into the claim, that limitation would be rejected as not supported by the disclosure. Applicant chose to use a precise cooling rate limitation rather than the imprecise terminology "furnace or air cooling" or "slow cooling".

The Response on this point concludes that "...the air cooling and furnace cooling of the ASM Handbook reference are typically conducted over a period of at least a few minutes, if not a few hours...." Since the discussion is about the limitation "second cooling the article to a temperature of less than about 800°F at a second cooling rate that does not exceed about 15°F per second", Applicant can only read this factual representation to mean that the ASM Handbook is said to teach that such a step of "second cooling" is accomplished "over a period of at least a few minutes, if not a few hours...." Applicant has carefully studied the pages provided, and can find no such teaching in ASM Handbook. Applicant acknowledges this statement as a factual representation by the Examiner, but asks that its precise source in ASM Handbook be pointed out.

With regard to argument (2), the argument is based on what is "commonly used", and the requirement of an affirmative teaching of a claim limitation is said to be met by an assertion that it would be obvious to combine forging with processes "that do not make forging of the alloy impossible." With regard to the first point, "commonly used" is not a class of statutory prior art recognized in 35 USC 102 or 35 USC 103. Applicant traverses this substitution of asserted "commonly used" prior art for a statutory prior art reference as applied in the context of the claim. Here, the matters asserted to be "commonly used" are not, in this context. Applicant requests that, if the rejection is maintained, the Examiner

apply a statutory prior art reference. MPEP 2144.03. Absent such an application of statutory prior art, Applicant requests that the rejection be withdrawn. With regard to the second point, an absence of impossibility is not the affirmative teaching required by MPEP 2143.03 and discussed at length in the Response of December 23, 2002.

With regard to argument (3), it is stated that: "there is no evidence to suggest that the different heat treatments used by ASM Handbook Volume 2 and Ruckle et al. would render the alloy useless for this task...." Applicant has no idea what this statement means in the context of Applicant's point, which had to do with the problems arising in attempting to combine isolated, unrelated teachings that are inconsistent with each other. As discussed in the Response of December 23, 2002, the processing of ASM and Ruckle are inconsistent. Applicant's point was that it is improper to select limited portions of references whose overall teachings are inconsistent, in building a rejection. With regard to the "intended use" statement, the pending claims are method claims, and statements of use and intended use are permitted in method claims. A limitation of intended use is not a valid limitation in an article claim, whose limitations may be addressed only to the physical structure of the article, but is permitted in a method claim.

Applicant submits that the application is in condition for allowance, and requests such allowance.

Respectfully submitted,
McNees Wallace & Nurick LLC

Carmen Santa Maria

Dated: June 24, 2003

Carmen Santa Maria
Reg. No. 33,453
100 Pine Street, P.O. Box 1166
Harrisburg, PA 17108-1166
Phone: (717) 237-5226
Fax: (717) 237-5300
Attorney for Applicant